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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,121	03/29/2001	Jack E. Haken	US 010141	5640
24737	7590	01/27/2005	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			FISH, JAMIESON W	
			ART UNIT	PAPER NUMBER

2616

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,121

Applicant(s)

HAKEN, JACK E.

Examiner

Jamieson W. Fish

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) filed on 18 June 2003 has been considered by the examiner.

Claim Objections

2. Claim 2 is objected to because of the following informalities: the use of "for" on line 3 makes the meaning of the ~~claim~~^{claim} difficult to ascertain. The claim has been evaluated with "for" omitted. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Regarding claim 13, the claimed invention is directed to non-statutory subject matter. The signal (if digital i.e. data packet) structure is a non-functional data structure and as such is non-statutory. The language "for remotely..." does not remotely control anything, it is **for** controlling. The electronic message is again a non-functional data structure of the signal. The non-functional data structure of a digital data packet signal is non statutory. Data such as music may be used for driving speakers. However, the data itself is non-statutory. In addition to being non-functional descriptive material, the signal is not tangibly embodied. See MPEP 2106.

Claim Rejections - 35 USC § 102

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Finseth et al. (US 6,813,775).

7. Regarding claim 1, Finseth teaches a memory associated with a programmable TV recorder (See Fig. 3 Recording Device 68, Memory 78, CPU 74 and Col. 7 lines 19-28) storing a list of authorized usernames (See Col. 13 lines 4-7) and computer readable instructions for programming a processor to monitor an input port capable of receiving schedule and software updates for a TV program recording recommendation (See Col. 7 lines 34-47, Col. 12 lines 66-67, Col. 13 lines 1-25, 43-48 The control program allows the CPU to receive data from an input port connected a network. Data includes viewing recommendations from others. For a receiver station that includes a recording device a viewing recommendation is equivalent to a recording recommendation, since recording is simply a recording device electronically "viewing" a program signal), to extract a username from the recommendation (See Col. 12 lines 66-67, Col. 13 lines 1-7 "evaluates the received viewing preference information"), to compare the extracted username to the list of authorized usernames (See Col. 13 lines 2-18 Comparison of extracted username to the list of authorized usernames is inherent

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to security measure), and to accept the recommendation when the processor determines the extracted username is an authorized username (See Col. 13 lines 2-18 "If the receiver accepts..").

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims **2-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Finseth et al. in view of Susskind (US 2001/0046366).

10. Regarding claim **2**, Finseth teaches wherein the step of accepting the recommendation comprises: displaying a list of recommendations in association with the username extracted from the recommendation (See Col. 13 lines 19-28 For the user to see the recommendations, the recommendations must be displayed); allowing an owner of the programmable TV recorder to enable or reject each displayed recommendation on the list (See Col. 13 lines 19-28 The user using the viewing preference information after it is stored to customize his or her profile is enabling the recommendation (i.e. building an user-specific customized program guide)); Finseth fails to disclose recording TV programs identified in the enabled recommendations and not recording TV programs identified in the rejected recommendations. However, it is well known in the art that a user profile can include programs that a user selects for recording as taught by Susskind (See Fig 4 Display TV Listings, Request new

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Recording Paragraph 35, 36 and 50). Therefore, it would have been obvious to one of ordinary skill in the ^{art} at the time the invention was made to modify Finseth to record TV programs identified in the enabled recommendations and not recording TV programs identified in the rejected recommendations as taught by Susskind, so that the owner of the programmable TV recorder could have a way to schedule the recording of selected programs so they could view the programs at a later time.

11. Regarding claim 3, Finseth and Susskind teach wherein the list of usernames comprises a first group of usernames and a mutually exclusive second list of usernames (See Finseth Col. 13 lines 15-18 Col. 17 lines 15-29. First group is senders of whose viewing preference information is merged into users own preference sub-history table. Second group is senders whose viewing preference information is merged into another sub-history table); wherein the step of accepting the recommendations includes automatically enabling recommendations if the user name extracted therefrom is in the first list (See Finseth Col. 11 lines 12-67 and Col. 12 lines 1-5 Since the user-specific sub-history is used to customize the user's profile, recommendations stored to user-specific sub-history are automatically enabled) and displaying on the list of recommendations other recommendations when the username extracted therefrom is on the second list (See Finseth Col. 17 lines 58-56 source-specific sub-history tables can be displayed by user, but do not necessarily customize the user's profile).

12. Regarding claim 4, Finseth teaches wherein the step of accepting comprises the receiving station displaying the recommendations so that user can make viewing decisions based on these recommendations (See Col 17 lines 65-67 and Col. 18 lines

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1-3). Finseth also teaches where the receiving station comprises a recording device controlled by the CPU of the receiver (See Fig. 3 Recording Device 68, CPU 74, Receiver 64, and Col. 7 lines 19-28). Finseth does not explicitly state wherein the step of accepting the recommendation comprises recording a TV program which is identified in the recommendation. However, a receiving station accepting a received command wherein accepting comprises recording a TV program is well known in the art as taught by Susskind (See Paragraph 41 Internet Remote Control Server sends recording commands to Video Recording Device). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Finseth's step of accepting such that it comprises recording an identified TV program as taught by Susskind so that the owner of the receiving station could view recommended television programs at a time later than the original broadcast time.

13. Regarding claim 5, Finseth teaches a memory associated with a programmable TV recorder storing computer readable instructions for programming a processor (See Fig. 3 Recording Device 68, Memory 78, CPU 74 and Col. 7 lines 19-28, 34-37) to monitor an input port capable of receiving schedule and software updates for a remote data (See Col. 7 lines 34-47, Col. 12 lines 66-67, Col. 13 lines 1-25, 43-48 The control program allows the CPU to receive data from an input port connected a network.), to extract a username and verification protocol from the remote data (See Col. 12 lines 66-67, Col. 13 lines 1-7 "evaluates the received viewing preference information"), to compare the extracted username and verification protocol to a stored username and verification protocol (See Col. 13 lines 2-18 Comparison of extracted username to the

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list of authorized usernames is inherent to security measure), storing data which can later be used by the viewer when the processor determines that the stored username and verification protocol match the extracted username and verification protocol (See Col. 12 lines 66-67 and Col. 13 lines 1-24). Finseth also teaches where the receiver can transmit and receive data via the internet (See Col. 12 lines 42-45). Finseth differs from the claimed invention in that his received data is not necessarily a remote command that updates a TV program recording schedule. However, updating a TV program recording schedule through a remote command transmitted via the internet is well known in the art as taught by Susskind (See Paragraph 35, 36, and 38). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Finseth such that his received data could also include a remote command for updating a TV program recording schedule as taught by Susskind. This would have been advantageous because it would allow the various users of Finseth's receive to update the receivers recording schedule remotely.

14. Regarding claim 6, Finseth teaches a programmable TV recorder that can receive data from a remote source and which records television program signals (See Fig. 3 Recording Device 68 and Col. 7 lines 19-28, 43-48 The recording device 68 is part of the receiving station 34. Since the recording device is shown to be controlled by CPU of the receiver 64, the receiver and recording device are effectively a programmable TV recorder), comprising: monitoring circuitry, which monitors a signal stream for a recording recommendation (See Fig. 3 Interface 82 and lines 43-48, and Col. 12 lines 66-67 and Col. 13 lines 1-8. Since recording is simply a recording device

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electronically "viewing" a program signal, a viewing recommendation is equivalent to a recording recommendation); means which extract a username from the recording recommendation and which generate a match signal when stored usernames include the extracted username (See Col. 12 lines 66-67 and Col. 13 lines 1-18 Match signal is inherent to security measure); and control circuitry, which effects a programmed response in response to the match signal (See Col. 13 lines 2-18 storing the viewing preference information is the programmed response). Finseth differs from the claimed invention in that the data received from the remote source does not necessarily have the capability to control the recording device. However, remotely controlling a TV program recorder is well known in the art as taught by Susskind (See Paragraph 35, 36, and 38). Therefore, since Finseth and Susskind both receive signals in a similar manner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Finseth's recording device such that it was capable of being controlled remotely as taught by Susskind thereby allowing the users of the recording device to control it without being in direct proximity.

15. Regarding claim 7, Finseth and Susskind teach ~~as~~ wherein the programmed response comprises addition of the recording recommendation to a list of recommended recording events (See Susskind Fig. 4 and Paragraph 35 and 50).

16. Regarding claim 8, Finseth and Susskind teach ~~as~~ wherein the programmed response comprises addition of a recording recommendation to a list of recommended recording events (See Finseth Fig. 4 Fig. 16, Col. 12 lines 33-35 Col. 13 lines 19-23, and Col. 17 lines 45-56 generating a program guide is displaying list of recommendation;

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adding a viewing recommendation to a list of recommended viewing events is equivalent to adding a recording recommendation to a list of recommended viewing events, since recording is simply a recording device electronically "viewing" a program signal).

17. Regarding claim 9, Finseth and Susskind teach wherein the programmable recorder further comprises a communication means for communication between the programmable recorder and a schedule server (See Susskind Fig. 2 Television Listings Server 25 and Paragraphs 29, 31, and 35 connection to internet is communication means); and monitoring means, for monitoring a signal stream received via the communication means for the recording recommendation (See Susskind Paragraph 41 Video Recording Device receives recording requests from Internet Remote Control Server monitoring is inherent to this process).

18. Regarding claim 10, Finseth and Susskind teach wherein: the stored usernames comprise a first list of usernames and a mutually exclusive second list of usernames (See Finseth Col. 13 lines 15-18 Col. 17 lines 15-29. First group is senders of whose viewing preference information is merged into users own preference sub-history table. Second group is senders whose viewing preference information is merged into another sub-history table); the match signal comprises first and second match signals (See Finseth Col. 13 lines 2-18 the CPU evaluates the received viewing preference information and stores it in either a separate user-specific sub-history table or merges it into a single common preference history table based on previous user designation. A first and second match signal are inherent to a CPU that evaluates

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incoming data to sort into two types of categories); the means generate the first match signal when the extracted username is in the first list and the second match signal when the extracted username is in the second list (See Finseth Col. 13 lines 2-18 Generation of a first and second match signal are inherent to CPU evaluating the received viewing preference information). Finseth teaches where there is a first programmed response to a the first match signal and a second different programmed response to the second match signal (See Col. 13 lines 2-18 and Col. 17 lines 15-29. Received data that generates the first match signal is added to the user-specific sub-history table. This adding is the first programmed response. Received data that generates the second match signal is merged into a single common preference history table. This merging is the second programmed response). Finseth teaches where the first program response adds the recommendation to the user-specific sub history table (See Col.13 lines 2-18 and Col. 17 lines 15-29) and where the second programmed response comprises addition of a recording recommendation to a list of recommended recording events in response to the second match signal (See Col. 13 lines 19-28 For a receiver station that includes a recording device a viewing recommendation is equivalent to a recording recommendation, since recording is simply a recording device electronically "viewing" a program signal). Finseth differs from the claimed invention in that the first programmed response adds the recording recommendation to the user-specific sub-history table and not to a recording schedule. However, the user-specific sub-history table is part of a user profile. It is well known in the art that a user profile can include programs that a user selects for recording as taught by Susskind (See Fig 4 Display TV Listings,

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Request new Recording Paragraph 35, 36, and 50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Finseth's first programmed response such that it added a recommendation to a recording schedule as taught by Susskind so that the owner of the recording device would be able to watch recommend programs if he or she was unable to view the program at the original viewing time even if he or she neglected to schedule the recommendation for recording.

19. Regarding claim **11**, Finseth teaches a programmable television recorder that can be remotely controlled and which records TV program signals (See Fig. 3 Recording Device 68 and Col. 7 lines 19-28. Recording device is part of receiving station. The recording device is shown to be controlled by the same CPU as the receiver of the receiving station, therefore the two electronic devices are equivalent to one electronic device with the functionality of both), comprising: means for monitoring a signal stream for one of a recording recommendation and a remote command (See Fig. 3 Interface 82 and Col. 7 lines 43-48. Since remote command and recording recommendation both come from a network, interface is a means to monitor a signal for each); means for extracting a username from the recording recommendation (See Col. 13 lines 2-18 CPU evaluating incoming data is means for extracting name from recording recommendation) and for extracting username and associated verification protocol from a remote command (See Col. 13 lines 2-18 Security measure involves extract username and verification protocol); means for distinguishing received data based on the username and associated verification protocol (See Col. 13 lines 2-18);

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means for storing the recording recommendation to a list of recommended recording events (See Col. 13 lines 19-25 For a receiving station with a recording device a viewing recommendation is equivalent to a recording recommendation). Finseth differs from the claimed invention in that the received data added to the user-specific sub-history table is not necessarily remote command that modifies a recording schedule. However, the user-specific sub-history table is part of a user profile and received data that changes the user-specific sub history table modifies the user profile. It is well known in the art that a user profile can include programs that a user selects for recording as taught by Susskind (See Fig 4 Display TV Listings, Request new Recording Paragraph 35, 36, and 50). Susskind also teaches a means for effecting the remote command to thereby modify the recording schedule (See Susskind Paragraph 35, 36, and 50). Since Finseth teaches distinguishing between two types of received data, where one type modifies and one is a recommendation, based on user name and Susskind teaches modifying a recording schedule, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Finseth so received data could be distinguished to either be stored as a recommend or effect the recording device by modifying the recording schedule as taught by Susskind. This modification would have been advantageous because it would allow the owner of a recording device to watch recommend programs from specific senders if he or she was unable to view the program at the original viewing time even if he or she neglected to schedule the recommendation for recording.

20. Regarding claim 12, Finseth and Susskind teaches the programmable recorder further comprises means for communicating between the programmable recorder and a schedule server (See Finseth Col. 7 lines 43-48 A connect to a network is a means for a programmable recorder to communicate with a schedule server); and the monitoring means monitors the signal stream received via the communicating means for the recording recommendation and the remote command (See Fig. 3 Interface 82 and Col. 7 lines 43-48 Interface is a means to monitor a signal stream for the recording recommendation and the remote command).

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morrison et al. (US 6,591,292) teaches a method where program information is sent from one user in a cable system to another user via an electronic message.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamieson W. Fish whose telephone number is 703-305-0884. The examiner can normally be reached on 8-5.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc Vu can be reached on 703-305-4946. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JF 1/12/05



NGOC YEN VU
PRIMARY EXAMINER